

REMARKS

This is a full and timely response to the Office Action mailed January 28, 2004.

By this Amendment, claims 1 and 16 have been amended to correct minor errors of form. Thus, claims 1-24 are currently pending for the Examiner's consideration. Support for claim amendments can be found throughout the specification and the original claims.

Applicant believes that all pending claims are in condition for allowance. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

Objections to Drawings

The Examiner objects to the drawings for containing improper descriptions. In response to this objection, Applicant has enclosed corrected Figures and requests that they be inserted into the disclosure.

Objections to Claim 16

Applicant has also amended claim 16 as per the Examiner's suggestion. Thus, withdrawal of this objection is also requested.

Rejections under 35 U.S.C. §102

Claims 1-3 and 16-18 are rejected under 35 U.S.C. §102(b) as being anticipated by Sasaki et al. (U.S. Patent 4,576,344). Applicant respectfully traverses this rejection.

As stated in Applicant's response of October 14, 2003, to constitute anticipation of the claimed invention under U.S. practice, the prior art reference must literally or inherently teach each and every limitation of the claims. Here, in this case, Sasaki et al. do not teach the claimed limitations "*said polyester film roll having a maximum diameter and a minimum diameter when all diameters of said roll are measured along the width direction of the roll, and the difference R between the maximum diameter value and the minimum diameter value is not more than $2W \times 10^{-3}$ and not more than $L \times 10^{-7}$, wherein W is the width of the film roll, and L is the length of the rolled*

film” and “wherein the first maximum perpendicular line length is not more than 500 μm , and the second maximum perpendicular line length is not more than 300 μm .”

The Examiner has argued in the Action that since Sasaki et al. teach a polyester film roll free from wrinkles and because the width of the roll is uniform throughout the roll, the minimum diameter value of the Sasaki et al. film roll is not more than $2W \times 10^{-3}$ and not more than $L \times 10^{-7}$. However, the Examiner’s argument is flawed since the claimed invention focuses on the difference (“R”) between the maximum diameter value and the minimum diameter value and not on the uniform width of the roll.

Sasaki et al. only teach a polyester film roll free from wrinkles by specifying roll hardness (25 microns) and centerline average surface roughness (0.001 to 0.05 microns) of the film roll using a touch roll. The reference does not at all address the deformities (wrinkles and slacks) form in a film roll cause by accumulated unevenness as the film is being rolled. Thus, it is clear that Sasaki et al. do not literally teach all the limitations of claim 1.

Sasaki et al. also fail to inherently teach all the limitations of claims 1 and 16 since the Examiner cannot provide a basis in fact and/or technical reasoning to reasonably support that the claimed limitations *“said polyester film roll having a maximum diameter and a minimum diameter when all diameters of said roll are measured along the width direction of the roll, and the difference R between the maximum diameter value and the minimum diameter value is not more than $2W \times 10^{-3}$ and not more than $L \times 10^{-7}$, wherein W is the width of the film roll, and L is the length of the rolled film” and “wherein the first maximum perpendicular line length is not more than 500 μm , and the second maximum perpendicular line length is not more than 300 μm .”* necessarily flows from the teachings of the Sasaki et al.

As the Examiner already knows, the fact that a certain result or characteristic (“*wrinkle free*”) may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). In relying upon the theory of inherency, the Examiner ***must provide a basis in fact and/or technical reasoning*** to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. In other words, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in

the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not, as applicable in this case, be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In this case, the Examiner has not provided any basis in fact and/or technical reasoning to reasonably support the determination that the above noted limitations necessarily flows from the teachings of Sasaki et al. The Examiner notes the teaching of the width in Sasaki et al. disclosure but does not explain its relationship with the maximum and minimum diameters of the polyester film roll. The Examiner only concludes that Sasaki's invention has "*found a way*" to account for all the unevenness of the film and create a roll which is free from wrinkles. However, the Examiner does not cite the teachings of such "*a way*" in Sasaki et al. which reads on the limitations of the claims. Instead, the Examiner only concludes without any basis in fact and/or technical reasoning that the film roll of Sasaki et al. would meet the recitations of the claims.

The Examiner has also noted that "*if it is still the Applicant's position that Sasaki et al. does not meet the limitation, then Applicant must provide evidence as to why Sasaki et al. does not meet the claim.*" However, the Examiner has not yet established a *prima facie* case of anticipation that the prior art reference literally or inherently teach the limitations noted above.

Under §2131 of the Manual of Patenting Examining Procedure, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown (*by the Examiner*) in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner has not met his burden of identifying "*in as complete detail as is contained in the claim*" where, in Sasaki et al., the limitations of the claims are taught or suggested either expressly or inherently. It should be noted that the key inventive concept of Sasaki et al. in obtaining a polyester film roll free from wrinkles is completely different than that of the present invention. In Sasaki et al. the prevention of the formation of wrinkles comprises controlling the roll hardness (H) of the film roll to a value satisfying the relationship $H \geq 0.67x^3 - 10.61x^2 + 55.54x - 1.16$

wherein $x = \ln(1/Ra)$. Such a relationship is completely distinguishable from that of the present invention. Thus, it is not possible for the Examiner to establish any basis in fact and/or technical reasoning to reasonably support the determination that the above noted limitations necessarily flows from the teachings of Sasaki et al.

Thus, since Sasaki et al. fail to literally and inherently teach each and every limitation of claims 1-3 and 16-18, withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. §103

Claims 4-15 and 19-24 are rejected under 35 U.S.C. §103(a) as being obvious over Sasaki et al. (U.S. Patent 4,576,344). Applicant respectfully traverses this rejection.

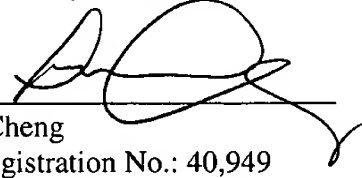
To establish a *prima facie* case of obviousness, the prior art references must either alone or in combination teach or suggest the invention as a whole, including all the limitations of the claims. Since, for the reasons noted above, Sasaki et al. fails to teach or suggest all the limitations of claims 1 and 16 from which claims 4-15 and 19-24 depend, this rejection also cannot be sustained and should be withdrawn.

CONCLUSION

For the foregoing reasons, all the claims now pending in the present application are believed to be clearly patentable over the outstanding rejections. Accordingly, favorable reconsideration of the claims in light of the above remarks is courteously solicited. If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the below-listed number.

Dated: April 27, 2004

Respectfully submitted,

By 
Lee Cheng
Registration No.: 40,949

RADER, FISHMAN & GRAUER PLLC
1233 20th Street, N.W. Suite 501 Washington,
DC 20036
(202) 955-3750
Attorneys for Applicant

Attachments

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 180013 for any such fees; and applicant(s) hereby petition for any needed extension of time.



Application No.: 09/914,033

Docket No.: TEI-0122

ANNOTATED SHEET SHOWING CHANGES



Fig. 1 Method of measuring Roll diameters in the width direction of the Film Roll

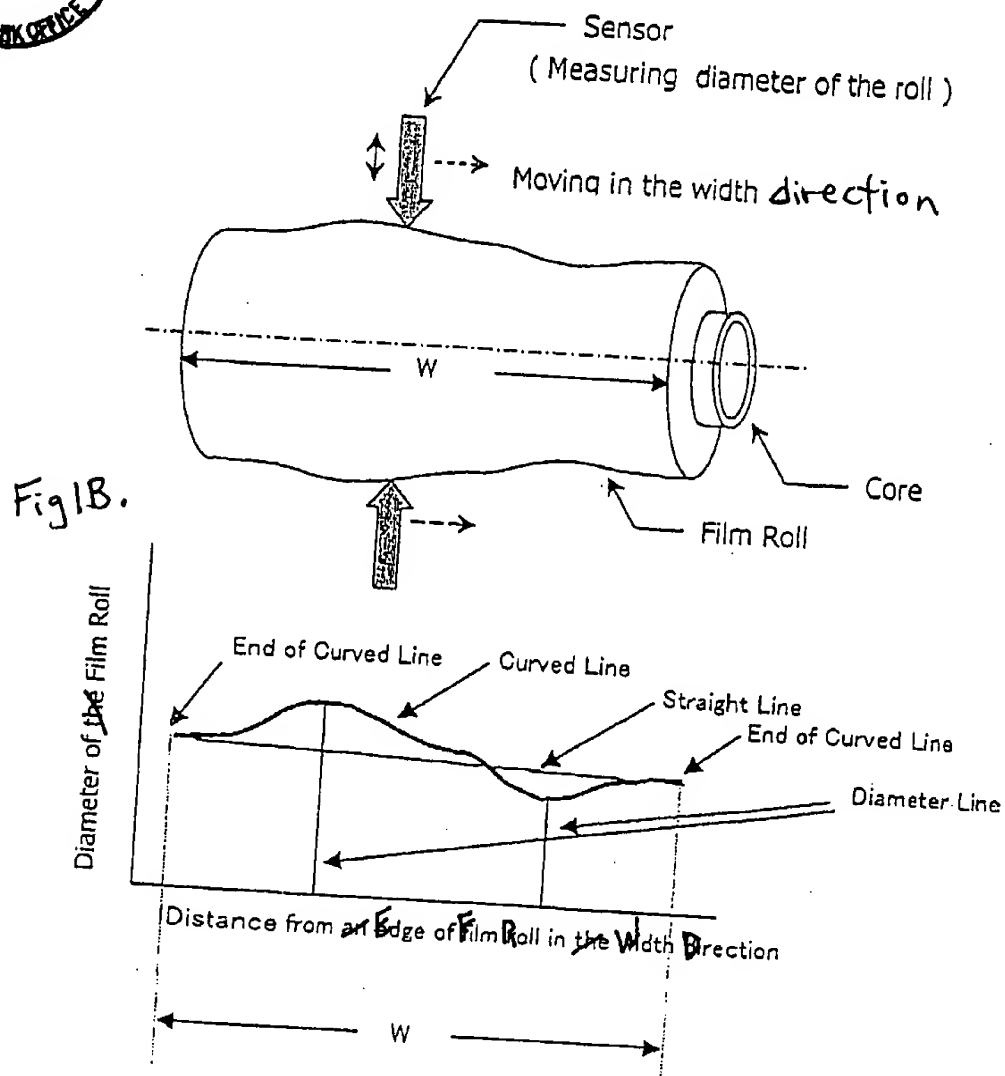




Fig. 1 Diagram for Claim 1

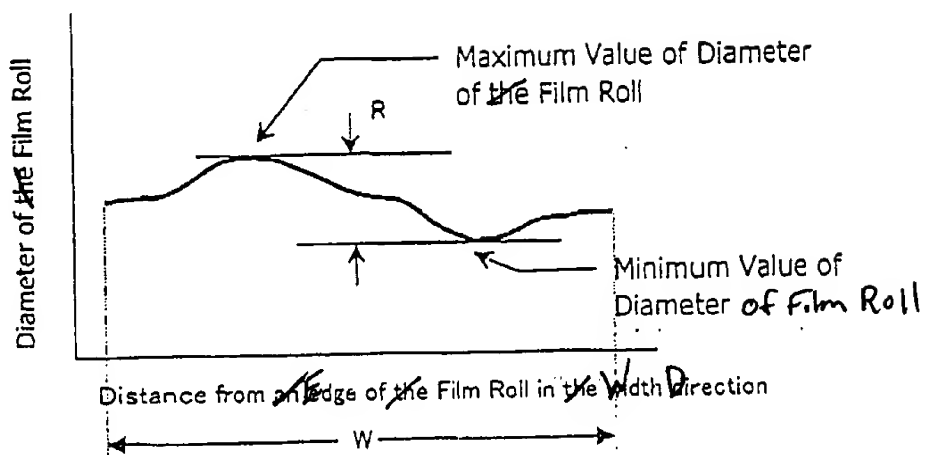
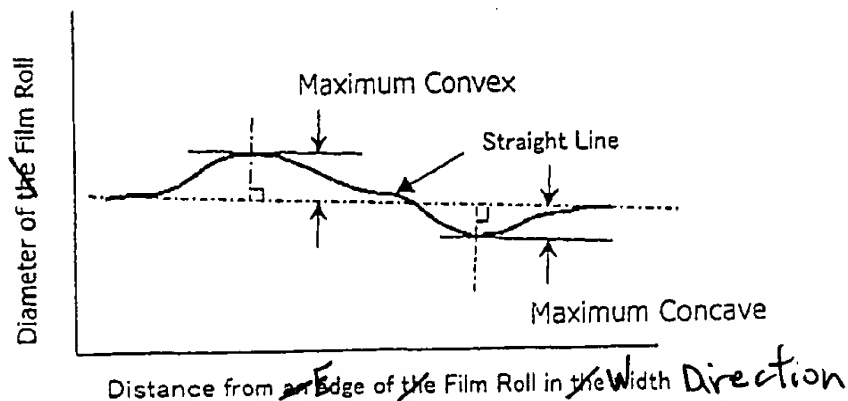
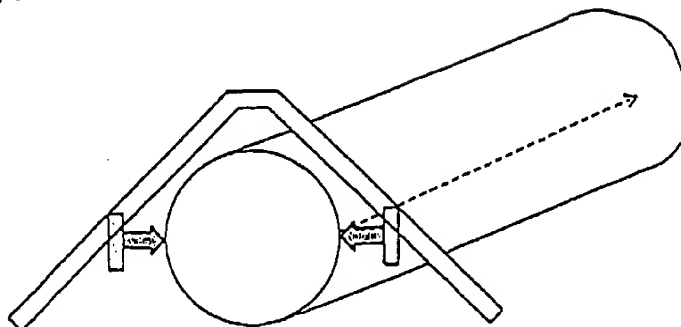


Fig. 3. Diagram for Claim 10

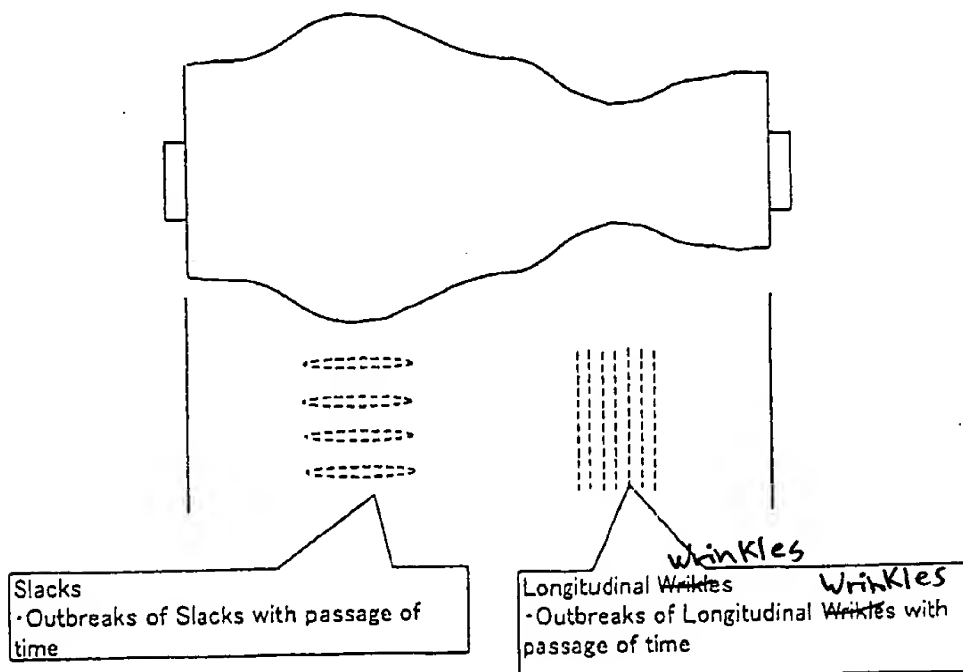




~~Fig5. Measuring Diameters of the Film Roll~~



~~Fig5. Image of Shape of the Film Roll~~



~~Fig6. Definition of the shape of the Film Roll~~

